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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,337	12/02/2003	Antoni Kozlowski	SHE0034.12	5278

21968 7590 06/16/2005

NEKTAR THERAPEUTICS
150 INDUSTRIAL ROAD
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EXAMINER

ASINOVSKY, OLGA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,337

Applicant(s)

KOZLOWSKI, ANTONI

Examiner

Olga Asinovsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 22-26 and 31-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 22-26 and 31-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/04/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Upon the amendment of 04/04/2005 the double patenting rejection under 35 U.S.C. 101 is withdrawn.

1. The terminal disclaimer filed on 04/04/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US patents No. 6,624,246 and No. 6,710,125 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-19, 22-26 and 31-33, 35-42 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolence et al U.S. Patent 5,650,234 (cited by applicants)

Dolence discloses a compound having polyalkylene oxide chain and reactive terminal carbonyloxy-N-benzotriazole groups represented by the formula (I) at column 2, lines 45-54. This compound is readable in applicants' claimed 1-benzotriazolylcarbonate ester having a water-soluble polyalkylene glycol. The PEG portion having a molecular weight of about 500 to about 20,000, col. 4, lines 62-63 is readable in applicants claims

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of being a water-soluble and non-peptidic polymer. The polyalkylene ether can be amine-grafted having free amino groups, col. 3, lines 41-43, for the present claims 22-25. Also, the compound can have a biologically active agent=bioactive compound connected to the surface of the compound of formula (I) through the free amino groups, col. 3, lines 36-45, for the present claims 25-26, 32-33, 35-42 and 44, or by a carbamate linkage, col. 3, line 61-63, for the present claim 35. An amine-grafted polymeric surface having free amino groups with a compound of formula (I) is readable in applicants' claim 23. A bioactive compound can include peptide and protein, col. 3, line 37 for the present claims 26, 39 and 44-45, col. 3, lines 23-25.

It would have been obvious to one of ordinary skill in the art to select the radical R5 being a carbonyloxy-N-benzotriazole and radical R1 being N-benzotriazole in the formula (I) col. 2, line 45 in Dolence invention, and, thereby, obtain 1-benzotriazolylcarbonate ester compound requiring in applicants' claims, because each definition for radicals R5 and R1 works within the same expectation to obtain the adequate results.

4. Claims 34 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shearwater Polymer, Inc. Catalog "Polyethylene Glycol Derivatives", 200, page 8 (cited by applicants) as applied to claims 1-19, 22-26, 31033, 35-42 and 44-45 above, and further in view of Dolence et al U.s. Patent 5,650,234.

The article "Polyethylene Glycol Derivatives" discloses branched PEGs, that are commercially available.

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Dolence does not disclose branched polyethylene glycol.

In light of the teaching in the Article "Polyethylene Glycol Derivatives", page 8, it would have been obvious to one of ordinary skill in the art to substitute PEG in Dolence invention with a branched PEG as disclosed in said Article since the reaction of polyethylene glycol with a benzotriazolyl carbonate will remain the same.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art has been considered.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

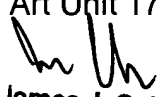
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 571-272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


June 10, 2005

Olga Asinovsky
Examiner
Art Unit 1711

James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700